

SHEARMAN & STERLING LLP

599 Lexington Avenue
New York, NY 10022-6069
+1.212.848.4000

sfishbein@shearman.com
212.848.4424

VIA ECF

November 1, 2021

Hon. P. Kevin Castel
United States District Judge
Daniel Patrick Moynihan
United States Courthouse
500 Pearl Street
New York, NY 10007-1312

Re: 1-800 Contacts, Inc. v. JAND, Inc. d/b/a Warby Parker (Case No. 1:21-cv-06966)

Dear Judge Castel:

We represent plaintiff 1-800 Contacts, Inc. in the above-captioned matter, and we submit this letter on behalf of both parties pursuant to paragraph 2 in this Court's August 24, 2021 Order (ECF No. 9). The initial pre-trial conference is set for November 8, 2021 at 11:30am.

Factual and Legal Bases For Claims & Defenses.

Plaintiff's summary of claims: 1-800 Contacts filed its Complaint for trademark infringement and unfair competition under the Lanham Act and state law on August 18, 2021. ECF No. 1. 1-800 Contacts alleges that Warby Parker, a new entrant to on-line sales of contact lenses, is causing consumer confusion by deliberately using 1-800 Contacts' well-known trademarks in its internet search advertising strategy. By bidding on 1-800 Contacts' trademarks, Warby Parker displays its own ad text in response to consumer searches for 1-800 Contacts that does not adequately identify Warby Parker as the source of the ads, and then directs consumers who have deliberately searched for 1-800 Contacts (and *not* Warby Parker) to a landing page that closely resembles the look and feel of 1-800 Contacts' website and is different from the landing page consumers are directed to if they search for Warby Parker contacts.

Defendant's summary of defenses: Warby Parker asserts that 1-800 Contacts' claims fail as a matter of law because 1-800 Contacts has plead insufficient facts to allege consumer confusion, which are necessary to sustain its trademark infringement claims. Specifically, 1-800 Contacts' Complaint demonstrates that Warby Parker's internet search ads and website landing pages adequately identify Warby Parker as the source, eliminating any consumer confusion. The Complaint also fails to allege that 1-800 Contacts has any protectable interest in the look and feel of its website such that consumers exclusively associate the design elements of the website with 1-800 Contacts and would be confused if they encountered these design elements on other websites. Multiple websites selling contact lenses use the same or similar design elements, and rather than

SHEARMAN.COM

Shearman & Sterling LLP is a limited liability partnership organized in the United States under the laws of the state of Delaware, which laws limit the personal liability of partners.

Hon. P. Kevin Castel

November 1, 2021

copy 1-800 Contacts' website, the Warby Parker advertising landing page is consistent with its own branding guidelines and the design of its homepage.

Contemplated Motions. On October 29, 2021, Warby Parker filed a pre-motion letter with the Court requesting permission to file a Rule 12(c) motion for judgment on the pleadings, and for a stay of discovery pending resolution of the motion. ECF No. 25. 1-800 Contacts opposes Warby Parker's motion and the request for a discovery stay and will respond to Warby Parker's October 29th letter within the time provided in this Court's rules.

Case Management Order. The parties attach hereto an agreed proposed Case Management Order to be used if the Court denies Warby Parker's request for a discovery stay.

Prospect for Settlement. 1-800 made a written settlement offer to Warby Parker in September 2021 which Warby Parker is considering.

Respectfully submitted,

/s/ Stephen Fishbein

Stephen Fishbein

cc: Counsel of record for Warby Parker (via ECF)